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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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07/824,287 01/23/92 OGAWA

K 04455/024001

WATKINS III, W **EXAMINER**

15N1/0602

FISH & RICHARDSON
601 THIRTEENTH ST., N.W.
WASHINGTON, DC 20005

ART UNIT	PAPER NUMBER
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1508

10

DATE MAILED: 06/02/93

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

- ☒ This application has been examined ☒ Responsive to communication filed on March 11, 93 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-23 are pending in the application.
Of the above, claims 12-23 are withdrawn from consideration.
2. ☐ Claims have been cancelled.
3. ☐ Claims are allowed.
4. ☒ Claims 1-11 are rejected.
5. ☐ Claims are objected to.
6. ☐ Claims are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).
12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received, ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

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15.

Claims 1-11 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim one, it is not clear how monomolecular and polymer films are distinct. In claim 1, it is also not clear how the CF_3 and siloxane groups are related. Are they on the same molecule? Is only one CF_3 or siloxane group required for the entire film? Claim 2 as amended reads "fine particles formed on the substrate surface fine particles present in said" which is unclear. In claim 3 "and fine particles" should be "and said fine particles". In claim 4, there is no antecedent basis for "the molecule". It is not clear how the substrate surface contains a CF_3 or siloxane group. In claim 6, it is not clear how the multi or monolayer and the irregular film are both formed on the substrate surface. Does "multimolecular layer" further limit the "polymer film" of claim 1? In claim 7, it is not clear how the "coated layer" and the monomolecular layer are oriented on the substrate. Does the "coated layer" coat the substrate or the monomolecular layer which is recited as being joined to the substrate? There is no antecedent basis for molecules in claim 7. It is also unclear how only a fluorocarbon or siloxane group is required in view of both being given in claim 1. In claim 8, the examiner accepts

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applicant's arguments that the members of the Markush group are in general distinct. In claim 9, it is not clear how the height is defined. What is the base point from which it is measured?

16a.

The request for a new declaration in section 16 of the office action mailed December 11, 1992 as Paper No. 7 is repeated.

16b.

Applicant is requested to cancel the non-elected claims.

17.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

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18.

Claims 1-10 are rejected under 35 U.S.C. § 103 as being unpatentable over Kido et al. in view of Ogawa '316 and Inoguchi et al.

The reasons for this rejection are given in section 20 of the action mailed December 11, 1992.

19.

Claim 11 is rejected under 35 U.S.C. § 103 as being unpatentable over Kido et al. in view of Ogawa '316 and Inoguchi et al. as applied to claims 1-10 above, and further in view of Ohno et al.

The reasons for this rejection are given in section 1 of the action mailed December 11, 1992.

20.

Applicant's arguments filed March 11, 1993 have been fully considered but they are not deemed to be persuasive.

Applicant argues that Kido et al. does not teach the size range of applicant. Applicant claims a surface irregularity of more than .01 micrometers in claim 1 and less than .3 micrometers in claim 11. The .03 micrometer value of Kido et al. meets both of these limitations. The 1 micrometer particle size refers to the particles in the film of Kido et al. and not the ultimate surface irregularities formed. Applicant further argues that Ogawa '316 and Inoguchi do not teach the entire invention. The

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examiner relies on neither reference to teach the entire invention. It is unclear from applicant's arguments which limitations of the invention are not met by which references of the rejections. Applicant also argues that Ohno is drawn to a recording film. Kido et al. and Ogawa '316 are also drawn to recording media. Applicant's claims read on recording media.

21.

Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

22.

Crystal Mall 1 Fax Center

A facsimile center has been established in Crystal Mall 1, room 10D08. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier number for accessing the facsimile machine is (703) 308-4227. This new location should be used in all instances when faxing any correspondence to Group 150. The existing facsimile center for the Patent Examining Corps can be used as a backup if you are unable to reach the Crystal Mall 1 center. The existing Patent Examining Fax Center telecopier

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numbers are (703) 308-3718 and (703) 308-3721. Use of the new Crystal Mall 1 center will facilitate rapid delivery of materials to the Group. The faxing of all papers must conform with the notice published in the Official Gazette, 1096 O.G. 30 (November 15, 1989).

23.

Any inquiry concerning this communication should be directed to William P. Watkins III at telephone number (703) 308-2420.

W.P.W.

Watkins/nrt
Tuesday, June 1, 1993

Alexander S. Thompson

ALEXANDER S. THOMPSON
PRESIDENT, BOARD OF
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